

Appl. No. 10/530,096  
Amdt. Dated October 3, 2007  
Reply to Office Action of July 3, 2007

**... ARGUMENTS / REMARKS ...**

The Office Action of July 3, 2007 has been thoroughly studied. Accordingly the changes presented herein for the application, considered together with the following remarks, are believed to place the application into condition for allowance.

By the present amendment, claims 1-10 have been withdrawn from prosecution.

In addition, the preambles of claims 16-18 and 32 have been changed to recite "the combination" of the claim from which they depend.

Claim 19 has been cancelled in favor of claim 15 which includes the limitations of claim 19.

Finally, new claim 33 has been added which recites the properties of the cured composition as found on pages 4 and 5 of applicants' specification.

Entry of the changes to the claims is respectfully requested.

On page 3 of the Office Action the Examiner has objected to claim 19, as failing to further limit the subject matter of claim 15.

In response to this objection, claim 19 has been canceled in the present amendment.

On page 4 of the Office Action the Examiner has rejected claims 16-18 and 32 under 35 U.S.C. §112, second paragraph.

Under this rejection the Examiner has stated that the preambles of claims 16-18 and 32 were not consistent with the preamble of claim 15.

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In response to this rejection, In addition, the preambles of claims 16-18 and 32 have been changed to recite "the combination" of claim 15 from which they depend.

Claims 15-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,922,991 to Bentz et al. in view of JP 200-154255 to Masayuki et al.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art or record and therefore, the outstanding prior art rejection of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon Bentz et al. as disclosing:

...an automobiles wire harness sealed by a sealing material to avoid the damages resulting from vibration, etc. (col. 1, line 12 to col. 2, line 25 and Figures).

The Examiner concedes that:

Bentz is silent on the use of the specific material set forth in the present invention for the seal.

Accordingly, the Examiner has relied upon Masayuki et al. as teaching:

...a sealing material comprising A) an acrylic polymer containing at least one alkenyl group, B) a hydrosilyl group-containing compound and a hydrosilylation catalyst ([0005], [0078], [0086] and Examples) Component A) can be derived from ethyl acrylate, n-butyl acrylate, 2-methoxyethyl acrylate and 1,7-octadiene. ([0008], [0032] and Examples) The molecular weight distribution of Component A0 can be 1.8 or less. ([0010]) The molecular weight of Component A0 is described in [0011]. The hardness of the cured composition is exemplified in [0094]. A filler can be used. ([0081]).

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In combining the teachings of Bentz et al. and Masayuki et al. the Examiner has taken the position that:

Since PJP225's material is substantially the same as that of Applicants', both should possess the same properties including compression set, loss tangent, etc. JP255's sealing material has a vibration absorption capacity for using in automobiles. ([0086]) The motivation of using the sealing material is to dampen the vibration. In light of the benefit mentioned, it would have been obvious....to utilize JP255's sealing material for Bentz's wire harness seal material with expected success/

Contrary to the Examiner's interpretation, it is noted that Bentz et al. actually teaches an "arrangement" for mounting a wiring harness on a support plate.

As stated at column 1, lines 44-52:

Direct connection between the connecting wires of the wiring harness and the electrical connection elements of the substrate, and embedding of at least a portion of the wiring harness into a sealing medium which encloses the connection, has the particular advantage of making possible long-lived, corrosion-resistant mounting of the wiring harness to the substrate. In particular, with this arrangement, no contact break can occur due to vibration or the like.

As can be seen the "arrangement" that primarily makes possible "long-lived, corrosion-resistant mounting of the wiring harness to the substrate" and also prevents breakage to occur due to vibration, involves structural features such as "[d]irect connection between the connecting wires of the wiring harness and the electrical connection elements of the substrate."

This structural "arrangement" is to be compared to the prior art disclosed by Bentz at column 1, lines 17-24 in which "edge connectors" were utilized – as opposed to direct connection with the connecting wires of the wiring harness.

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Thus, Bentz does not actually teach that the sealing material itself is relied upon as being required to have a required vibration absorbing characteristic.

In fact, Bentz teaches that the sealing materials "can be composed, for example, of polyurethane or silicone or the like."

Further, Bentz only teaches that the sealing material "performs the function of a strain relief, since at least a portion of wiring harness 60 is embedded in sealing medium 70."

As the Examiner is no doubt aware, strain relief refers to the resistance of pulling on the wire harness and is not the same as vibration effects (which might necessitate a vibration absorbing material).

Further, the polyurethane or silicone of Bentz is clearly materials that are known for use as corrosion-resistant sealing materials – as expressly noted by Bentz.

Masayuki et al. teaches a curable composition that can be used as a vibration absorbing material for automobiles.

However, in paragraph [0086] Masayuki et al. only teach that:

the composition can be used as automobile body parts such as airtight sealing materials, glass vibration controlling materials, vibration absorbing materials, especially for window seal gaskets and door glass gaskets. The composition can also be used as parts for chassis such as vibration- or sound-absorbing rubber for engines and suspensions, especially for engine mount rubber.

In addition, in the last portion of the same paragraph it is taught that: "the composition can be used as vibration-absorbing rubbers for automobiles."

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There is no description or mention in Masayuki et al. as using the composition in conjunction with wire harness seals.

Thus, the combination of Bentz and Masayuki et al. finds no particular support in the teachings of these references, inasmuch as Bentz teaches polyurethane or silicone that are known for use as corrosion-resistant sealing materials (as stated by Bentz) and Masayuki et al. does not teach application of the disclosed compositions to wire harnesses.

In contrast to the prior art of record, during the course of the present invention, applicants discovered that the claimed compositions provides excellent adhesiveness to wire harnesses (not taught or suggested by Masayuki et al.), with low out gassing and excellent compressive set characteristics.

It noted that the Examiner has taken the position that:

Since PJP225's material is substantially the same as that of Applicants', both should possess the same properties including compression set, loss tangent, etc.

This statement appears to indicate that the Examiner is taking the position the properties that Masayuki et al. provides to Bentz are inherent to the compositions of Masayuki et al.

As held by the court of appeals in *In re Shetty*:

Inherency is quite immaterial if, as the record establishes here, one of ordinary skill in the art would not appreciate or recognize that inherent result.

The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is not known. *In re Shetty*, 195 USPQ 753 (CCPA 1977)

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In the present situation Bentz, who teaches polyurethane or silicone, would certainly not recognize or appreciate any of the properties or characteristics of the compositions of Masayuki et al.

Therefore, any improvements related to the compositions of Masayuki et al. (if properly combinable with Bentz) would not have been obvious.

On page 4, line 5 from the bottom through page 5, line 10 applicants teach:

Particularly the sealing material for automobile wire harnesses requires the following characteristics.

- (a) Good heat resistance and ozone resistance corresponding to the automobile using circumstances,
- (b) Distinguished compression set characteristics governing a sealability,
- (c) Distinguished tight adhesiveness to electric wires,
- (d) Less insertion resistance at the time of electric wire insertion and low hardness, and
- (e) No occurrence of cracks on the seals even if the seals are damaged at the time of electric wire insertion.

Most, if not all, of these characteristics are unexpected over the combination of Bentz and Masayuki et al.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

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It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejections of the claims should hence be withdrawn.


Therefore, reconsideration and withdrawal of the outstanding rejections of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,

  
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